

REMARKS

This Amendment is in response to the Office Action mailed June 23, 2008. Claims 1-3, 5-7, 9, 17-20, 22-24 and 26-31 are pending in the application and are rejected. Applicant responds to the Office Action as follows.

Response to Claim Rejections – 35 U.S.C. § 103

Claims 1-3, 5-7, 9, 17-20, 23 and 26-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gidumal, U.S. Patent No. 6,296,691 in view of Dodd, U.S. Patent No. 6,116,373. Claims 2, 17 and 27 are cancelled. Claims 1 and 9 are independent claims. Claim 1 as amended recites an airflow guide that projects from a housing comprising an elongate elastomeric body forming a barrier surface that is non permeable to air flow along an elongate length of the elastomeric body to guide the airflow in a desired path as illustrated in FIGS. 2-3 of Applicant's specification. Claim 9 as amended recites an airflow guide that projects into the housing and comprises an elastomeric body forming a barrier surface that is non-permeable to fluid flow to guide fluid flow in a desired path.

The claimed air flow guide is supported by Applicant's specification. As disclosed in Applicant's specification, the claimed air flow guide is formed of an elastomeric body. The air flow guide servers as a flow diverter for directing fluid away from components, a guide for directing fluid toward a region, for example, a filtration unit, or for encouraging laminar flow to prevent turbulent flow. Applicant's specification, ¶[0017]. As appreciated by those skilled in the art, the air flow guide comprising an elastomeric body as disclosed in Applicant's specification is non permeable to air or fluid flow to channel, divert or direct fluid or air flow as claimed.

Claims 1 and 9 are rejected in part on the basis of item 11 in FIGS. 2A and 2B of Gidumal. In Gidumal, item 11 is a molded filter which is permeable to fluid flow to remove particulate contaminants from incoming (external) air and recirculating air by performing both breather and recirculating functions when placed over a breather filter hole. As described, the molded filter 11 includes multiple filtration layers including an inner filter layer 22, filtration layer 24 and outer protective layer 26. As shown in FIG. 8 of Gidumal, in an illustrated embodiment,

filter 11 is adhered to a damping material 44, but as acknowledged in the Office Action, Gidumal does not teach forming walls of filter 11 of an elastomeric material.

Although it is acknowledged that Gidumal fails to disclose wherein the walls of filter 11 are an elastomeric damping material, the Office Action states that it would have been obvious to a person with ordinary skill in the art at the time of the invention to employ an elastomeric material as taught by Dodd as the elastic walls of filter 11 in Gidumal because it would damp the vibrations created by the air flow and the rotation of the discs. As set forth in paragraph 4 of the Office Action, the test for combining reference is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.

An obviousness rejection must be evaluated in view of the factors as set forth in *Graham v. John Deere*. As set forth in *Graham*, the scope and content of the prior art must be determined, differences between the prior art and the claimed invention must be ascertained and the level of ordinary skill in the pertinent art must be resolved. Additionally, the claimed invention and references must be considered as a whole including those portions of a reference which teach away from the claimed invention. Obviousness must also be evaluated without the benefit of impermissible hindsight and there also must be a reasonable expectation of success to render a claimed invention obvious in view of the prior art.

Gidumal discloses a breather/recirculation filter 11. One of ordinary skill in the art would understand that the breather/recirculation filter 11 needs to breathe to allow air flow therethrough, Declaration of Mo Xu ¶ 3. Thus one skilled in the art would form walls of the breather/recirculation filter 11 of a porous or permeable material or alternatively include holes in the walls of the filter structure 11. One of ordinary skill in the art would also understand that the elastomeric or damping material of Dodd prevents airflow through slots 24. Declaration of Mo Xu ¶ 4. Thus when the references are considered as a whole, it would not be obvious to form walls of filter 11 of an elastomeric material since the breather/recirculation filter must breathe to allow air flow therethrough.

Considering the claimed subject matter and the cited references as a whole, the Office and Applicant can agree that the Gidumal reference requires a permeable surface for its filter 11,

but that the damping material 30 of Dodd is non permeable. Specifically, Gidumal states that filter 11 “is typically put into an area of high air flow. . . This forces air through the filter effecting particulate filtration . . .” Gidumal, col. 7, lines 1-9. Further as disclosed in Dodd, slots 24 are filled with the damping material 30 in order to reduce structural resonance (Dodd, col. 4, lines 4-5 & Abstract) and as established by the Declaration of Mo Xu, the damping material of Dodd is non permeable. Thus, as established by the Declaration of Mo Xu, the skilled artisan readily recognizes that making the filter 11 of the elastomeric material 30 as taught by Dodd defeats the filter’s purpose. If a proposed modification is unsatisfactory for its intended purpose, then the combination is not obvious. MPEP § 2143.01.

Claims 3, 5-7 and 26 are dependent upon claim 1 and claims 18-20, 23, 28-31 are dependent upon claim 9 and are allowable as discussed above.

Claims 6 and 20 recite wherein the airflow guide is formed in place to a cover of the housing, which is not taught in Gidumal nor Dodd. Claim 29 as amended recites wherein the elastomeric body is extruded in an elongate “U” shaped pattern to form a “U” shaped body portion on the housing, which is not disclosed in FIGS. 1A-8 nor col. 6, line 57 – col. 9, line 35 of Gidumal as stated in paragraph 2 of the Office Action.

Claims 22 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gidumal, U.S. Patent No. 6,296,691 in view of Dodd, U.S. Patent No. 6,116,373 and further in view of Izumi, U.S. Patent No. 6,008,965. Claims 22 and 24 are dependent upon claim 9 and are allowable *inter alia* for the reasons discussed above.

Based upon the foregoing, allowance of claims 1, 3, 5-7, 9, 18-20, 22-24, 26, 28-31 is respectfully requested.

New claims 32-34 are added. Favorable action with respect to new claims 32-34 is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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